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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,176	10/28/2003	Robert Silva	29757/P-759	4294

4743 7590 04/05/2007

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EXAMINER	
OMOTOSHO, EMMANUEL	
ART UNIT	**PAPER NUMBER**
3714	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/695,176	SILVA ET AL.	
	Examiner	Art Unit	
	Emmanuel Omotosho	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 February 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-51* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-51* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner: Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-15, 17-51 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-34 of Chamberlain U.S. Patent Appl No. 10/178876 in view of Slomiany et al. US Patent No. 6612927. Chamberlain discloses all of the claimed subject matters except providing means for the game machine to:

a. Prevent a second wager on a first game type when the payout for the first game type is at least a predetermined value

b. Generate a second game (be it the same game type as the first game or a different game type) when the payout for the first game type is at least a predetermined value.

c. Receive a second wager on the first game type if the second game payout has been determined and a reset signal has been received.

2. However, in a similar invention, Slomiany et al. discloses a method for interconnecting a plurality of gaming apparatuses (specifically, any casino gaming system) to form a network of gaming apparatuses (See Fig 3 and Column 4 Fourth Paragraph). It should be noted that Internet is also a type of network, thus it falls within the scope of Slomiany et al.'s reference. Slomiany et al. also discloses a gaming apparatus comprising of a controller housing computer programs capable of generating

a game display for different types of known casino games (See Column 2 lines 43-50). Slomiany et al. reference further discloses a method for a gaming system comprising of n stages. Where each stage is a type of game such as slots, poker, keno etc. For example, the first stage could be a type Slots while the second stage is a different type of game (such as Keno or Poker) or a new session of the first game type (slots). Each n+1 stage could be dependent or independent of the events of the n stage. The motivation for dependency and game types is by choice (See Column 1 lines 55-67). The game advances to the next game upon an advancement condition set by the system. Once the advancement condition is met, the system is signaled to advance to the next stage. The advancement condition is also set by choice (See Column 2 lines 38-42 and Column 4 line 62 – Column 5 line 3). Thus, it would be obvious for someone of ordinary skill to have combine the Chamberlain et al.' reference with Slomiany et al.'s reference wherein the advancement condition is the determination of the payout value of stage n reaching a predetermined value. The motivation behind this comes from the well-known system lockup event that happens when the player hits a jackpot and the player has to wait several minutes for the attendant to come signal the system to allow the player to continue playing a new game of the same type or a totally different game.

3. Claims 4 and 16 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-34 of Chamberlain and Slomiany et al. as described above and further in view of Cole et al. US App No. 09/904061. Cole et al. discloses a gaming system wherein the system comprises of an electronic payout system that automatically credits a players account in the amount of the payout

associated with an outcome of a game (See Abstract). Therefore it would be obvious for someone of ordinary skill to combine the System B above with Cole et al.'s reference to include an electronic pay system. The motivation comes from the Abstract where it states that the invention helps avoid extended lock-up period common in a conventional gaming system for recording of jackpot information whenever a significant jackpot is won.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loose et al. US 6517433 in view of Slomiany et al. US 6612927.

3. As can be seen in Fig. 11, Loose et al. discloses a gaming apparatus comprising of a value input device (See Column 3 lines 28-32), a display unit coupled to a controller comprising of a processor coupled to a memory system. In response to a wager for a slot machine first game, the controller is programmed to display video images relating to the first game through the display unit. However, Loose et al. did not show the following:

a. a system where the controller is coupled to a memory system housing computer programs capable of generating a game display for different types of casino games such as a wide area progressive game, poker, blackjack, keno etc.

b. a system comprising a plurality of gaming apparatuses interconnected to form a network of gaming apparatuses

c. a system comprising a programmed controller capable of allowing a wager on a second game, displaying video images relating to the second game when the first value payout for the first game is determined to be at least a predetermined amount.

4. Moreover, in a similar invention, Slomiany et al. discloses a method for interconnecting a plurality of gaming apparatuses (specifically, any casino gaming system) to form a network of gaming apparatuses (See Fig 3 and Column 4 Fourth Paragraph). It should be noted that Internet is also a type of network, thus it falls within the scope of Slomiany et al.'s reference. Slomiany et al. also discloses a gaming apparatus comprising of a controller housing computer programs capable of generating a game display for different types of known casino games (See Column 2 lines 43-50). Slomiany et al. reference further discloses a method for a gaming system comprising of n stages. Where each stage is a type of game such as slots, poker, keno etc. For example, the first stage could be a type Slots while the second stage is a different type of game (such as Keno or Poker) or a new session of the first game type (slots). Each n+1 stage could be dependent or independent of the events of the n stage. The motivation for dependency and game types is by choice (See Column 1 lines 55-67).

The game advances to the next game upon an advancement condition set by the system. Once the advancement condition is met, the system is signaled to advance to the next stage. The advancement condition is also set by choice (See Column 2 lines 38-42 and Column 4 line 62 – Column 5 line 3). Thus, it would be obvious for someone of ordinary skill to have combine the Loose et al.' reference with Slomiany et al.'s reference wherein the advancement condition is the determination of the payout value of stage n reaching a predetermined value. The motivation behind this comes from the well-known system lockup event that happens when the player hits a jackpot and the player has to wait several minutes for the attendant to come signal the system to allow the player to continue playing a new game of the same type or a totally different game.

5. In regards to claim 5, Loose et al. discloses a system wherein the display unit is capable of generating video images (See Abstract).

6. In regards to claim 6, Slomiany et al. discloses a gaming system comprising of a controller programmed to cause a video display of any type of the known casino games (See Column 7 lines 39-53).

7. In regards to claim 7, Loose et al. discloses the display unit comprising of at least one mechanical slot machine reel (See fig 1.).

8. In regards to claims 8-11, Slomiany et al. discloses a system wherein the controller is programmed to cause the display to generate a second stage (or game) display relating to the same/different game type of the first game (the choice is up to the user) (See Column 2 lines 43-50 and Column 7 lines 39-53).

9. In regards to claims 12-18, Slomiany et al. discloses a controller programmed to prevent a second wager on said first game type if an advancement condition is met (See Column 4 line 67-Column 5 line 9). Wherein, the controller is also programmed to cause the display unit to generate a menu display comprising options for two or more games for the user to play (See Column 2 lines 39-50).

10. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Loose et al. and Slomiany et al. as applied above, and further in view of Cole et al. 09/904061. Cole et al. discloses a gaming system wherein the system comprises of an electronic payout system that automatically debits a players account in the amount of the payout associated with an outcome of a game (See Abstract). Therefore it would be obvious for someone of ordinary skill to combine the System B above with Cole et al.'s reference to include an electronic pay system. The motivation comes from the Abstract where it states that the invention helps avoid extended lock-up period common in a conventional gaming system for recording of jackpot information whenever a significant jackpot is won.

Citation of Pertinent Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure

Acres et al., US 5655961, discloses method for operating networked gaming devices

Fier, US 6126542, discloses gaming device and method offering primary and secondary games

Brandstetter et al., App No. 09/982437, discloses gaming device having a second separate bonusing event

Yoseloff, US 6312334b1, discloses method of playing a multi-stage video wagering game

Wilder et al., US 2005/0059487 a1, discloses three-dimensional auto stereoscopic image display for a gaming apparatus

Lemay et al., US 2004/0063495 A1, discloses EPROM file system in a gaming apparatus

Mead, US 2004/0063486, discloses Apparatus and method for player interaction

Lemay, US 2003/0186734 A1, discloses a gaming machine including a lottery ticket dispenser

Nguyen et al. US 2003/0186745 A1, discloses an apparatus and method for a gaming tournament network.

Response to Arguments

11. Applicant's arguments filed 2/13/2007 in regards to obviousness-type double patenting rejection of claims 1-15 and 17-51 have been fully considered but they are not persuasive. Applicant argues, "it is clear that an obviousness-type double patenting rejection can only exist between an application and an issued patent". However, applicant respectfully disagrees. It is not required for the second reference to be an issued patent (See MPEP 804). In regards to the prima facie related arguments, please see below for response.

12. Applicant's arguments filed 2/13/2007 in regards to claims 1-51 rejected under 35 U.S.C. 103(a) as being unpatentable over Loose et al. ("Loose") in view of Slomiany et al. ("Slomiany") and further in view of Cole et al. ("Cole") have been fully considered but they are not persuasive.

13. On Page 17, applicant argues, "the action does not establish a prima facie case of obviousness of claims 1-51 because the action has not demonstrated where either Loose et al. or Slomiany et al. discloses all of the limitations as recited by independent claims 1, 4, 24, 41 and 47. In particular, while the action appears to address some of the features of independent claims 1, 4, 24, 41 and 47, the action does not address the features of preventing a second wager on a first game type if at least a predetermined (or nonzero) value payout associated with the first game type is determined and receiving wager data representing a second wager on the first game type if reset data is received."

14. However, the examiner respectfully disagrees. Applicant should realize that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claim language presented by the applicant is broad, thus, all claims were given its broadest-reasonable interpretation. Therefore Loose in view of Slomiany disclose all of the limitations as described above. For example, take claim 1 that recites "said controller being programmed to receive reset data representing a reset signal, said controller being programmed to receive said second wager on said first type if said controller received said reset data and

determined said second value payout". This phrase by itself is extremely broad and reads on several features well known and quite inherent in the gaming environment. For example, the reset signal could be the option giving at the end of a game session that allows the player to restart the game if more tokens are deposited within x amount of time. The option is usually given to player when all value payouts (in this case, all values includes the second value payout) are determined. In this case, the reset signal would be the signal received by the controller when the tokens are deposited. Another example could be from Slomiany's reference Fig 10E in which when all payout values are determined (El. 223), the system is capable of sending a reset signal to a controller to reset/restart the game. To further elaborate on the examiners interpretations, applicant should note that Slomiany provides a gaming system that offers the player to place a bet on more than one different game type. Slomiany offers several embodiments in which one can see the various situations where the invention could be applied. In one embodiment, Slomiany disclose a system where the player is able to place bets on more than one game in which the game type is up to the player to choose (Col 8 lines 6-20) the advancement criteria is based on a win/loose situation (a win is well known in the art to be a non zero amount, for example a jack pot) (Col 10 lines 19-25). Once this winning event is determined, the controller does not offer the player to place a bet on the first game since the controller is programmed to generate the second level (game) once the winning event is determined (Col 8 lines 6-20). Therefore, the references as shown above disclose all limitations of the present invention.

15. On page 18, applicant further argues, "For example, if the player did not wager on the second stage, the player may continue wagering on the first stage even upon the occurrence of an advancement condition (e.g., a winning condition)"

16. However, the applicant should note that even if that were true, Slomiany's reference is particularly related to a game comprising a plurality of stages, as suppose to a game comprising of one stage. Examiner is interpreting the applicant's invention to be related to a game comprising of more than one stage (or game), therefore, the "plurality of stages" Slomiany embodiment is also being used for examination purposes.

17. On page 19-20, applicant further argues, "still further, the motivation provided in the action is insufficient because the asserted motivation (i.e., player wait time due to a system lock-up event) is not found within the disclosures of Loose et al. or Slomiany et al. indeed, the action does not provide any indication as to the source of the motivation, whether explicitly or implicitly in the references themselves. Instead, the action asserts, without any supporting evidence, that "the motivation ... comes from the well-known system lockup event that happens when the player hits a jackpot and the player has to wait several minutes of the attendant to come signal the system to allow the player to continue playing a new game of the same type of a totally different game." However, the asserted motivation is clearly dubbed from the disclosure of the application (see application, page 1, lines 4-32)". Moreover, On page 20, "Still further, the asserted motivation only identifies a problem within the prior art, but does not motivate one of ordinary skill in the art as to the solution to the problem. Even if the problem was well known to one of ordinary skill in the art, the action, has not established that one of

ordinary skill in the art would have found the prevention of a second wager on a first game type and the generation of a display of a second game type if a first value payout of at least a predetermined (or nonzero) amount was determined, as an obvious solution, to the problem of player wait time due to a system lockup event. Although a motivation to combine references may be found in the nature of the problem to be solved, one of ordinary skill in the art must still be motivated to combine the references to obtain the solution. For example, the motivation, to combine the reference may be found in the nature of the problem to be solved if each reference is directed to the asserted problem. Ruiz v. A.B. Chance Co., 357 F.3d 1270, 69 USPQ2d 1686 (Fed. Cir, 2004). See also MPEP 2143.01."

18. However, the examiner respectfully disagrees. The motivation was in no way dubbed from the applicant disclosure. Applicant should first respectfully note that "a reasonable man" is deemed to be a "person of ordinary skill in the art" who is ***presumed*** to be aware of all prior art. The motivation, in itself, is granted from what is well known in the art. For example, take Cole's reference disclosed above. Cole's reference (at least) further proves that the examiner's *asserted motivation* is well known in the art (abstract). Moreover, in regards to the argument relating to the suggestion to combine, the examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references, In re Nomiya 184 USPG 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the

combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA 1969). In this case, the jackpot event lockup is well known in the art, thus the motivation to combine is well within the skill set of an ordinary skill artisan to combine.

19. The examiner recognizes that the applicant made similar arguments for the rest of the rejections, therefore, the same response as described above holds.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing any further responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner

Conclusion

20. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emmanuel Omotosho whose telephone number is (571) 272-3106. The examiner can normally be reached on m-f 8-430.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571)272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EO

Ronald Laneau
Primary Examiner
4/2/07